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FROM: MATTHEW C. LOPPNOW (847) 523-2585
(SENDER'S NAME) (EXTENSION)

RE: APPLICATION NO. 09/769,938

TOTAL NUMBER OF PAGE(S) 18 **(INCLUDING THIS PAGE)**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 APPLICANT: Barros et al. EXAMINER: To, B.
SERIAL NO.: 09/769,938 GROUP: 2172
FILED: January 26, 2001 CASE NO.: PT03398U
10 ENTITLED: COMMUNICATION DEVICE, SYSTEM, METHOD, AND COMPUTER
PROGRAM PRODUCT FOR SORTING DATA BASED ON PROXIMITY

15 Motorola, Inc.
Intellectual Property Department
600 North U.S. Highway 45
Libertyville, IL 60048

20 APPEAL BRIEF UNDER 37 C.F.R. § 1.192(c)

25 MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

30 Further to the Notice of Appeal filed on August 24, 2004, Applicant submits the
present Appeal Brief in triplicate.

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I. REAL PARTY IN INTEREST

The real party in interest is, Motorola, Inc.

5

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

10

III. STATUS OF CLAIMS

Claims 1-24 are pending. Claims 1-24 are rejected and are the subject of the present appeal.

15

IV. STATUS OF AMENDMENTS

No amendment was filed subsequent to the February 24, 2004 final office action.

V. SUMMARY OF INVENTION

20

The inventions are drawn generally to data processing systems having sorting algorithms (page 1, lines 4-5). For example, the inventions are drawn to determining a position of a user within a zone and sorting data records, where the data records are associated with a related zone and sorting is according to proximity of said related zone of said data

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records in relation to said position of the user (page 2, lines 12-14, lines 29-32, Fig. 2, elements 212, 214, 216, and 218, Fig. 3, element 318).

VI. ISSUES

5

1. Whether claims 1-8 and 19-24 are patentable under 35 U.S.C. § 103 over DeLorme et al. (U.S. Patent No. 6,321,158).
2. Whether claims 9-18 are patentable under 35 U.S.C. §103 over Stilp et al. (U.S. Patent No. 6,159,465) and Wakabayashi et al. (U.S. Patent No. 5,794,222).

10

VII. GROUPING OF CLAIMS

Claims 1-8 and 19-24 stand or fall together regarding the rejection thereof under 35 U.S.C. § 103 over DeLorme et al. (U.S. Patent No. 6,321,158).

15

Claims 9-18 stand or fall together regarding the rejection under 35 U.S.C. § 103 over Stilp et al. (U.S. Patent No. 6,159,465) and Wakabayashi et al. (U.S. Patent No. 5,794,222).

VIII. ARGUMENT

20

Claim Limitations At Issue

In Claim 1, the limitations at issue are italicized below:

1. A method for sorting data records comprising:

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- (a) *determining a position of a user within a zone; and*
- (b) *sorting data records, wherein said data records are associated with a related zone, wherein sorting is according to proximity of said related zone of said data records in relation to said position of the user.*

5

In Claim 9, the limitations at issue are italicized below:

9. A communication device comprising:

a processor operative to access a plurality of records and position information,
10 wherein the processor is operative to *sort said plurality of records based on a first detected position.*

Examiner's Allegation

15 Claims 1-8 and 19-24 stand rejected under 35 U.S.C. § 103 over DeLorme et al. (U.S. Patent No. 6,321,158).

Claims 9-18 stand rejected under 35 U.S.C. § 103 over Stilp et al. (U.S. Patent No. 6,159,465) and Wakabayashi et al. (U.S. Patent No. 5,794,222).

20 Applicants' Argument

Claims 1-8 and 19-24

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Applicant asserts there is absolutely no disclosure in DeLorme of sorting according to proximity of a related zone of data records in relation to a position of a user, as recited in independent claims 1, 19, 21, and 23, and such is not obvious.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

The first Office Action admits DeLorme does not explicitly teach sorting according to proximity of a related zone of data records in relation to the position of a user and no reference is supplied that teaches this missing limitation.

There is absolutely no disclosure in DeLorme of sorting according to proximity of a related zone of data records in relation to the position of a user. As required by MPEP 2142, the prior art references, when combined, must teach or suggest all of the claim limitations. DeLorme does not teach or suggest the claimed feature of sorting according to proximity of a related zone of data records in relation to the position of a user. In fact, the first Office Action admits this feature is not taught. Furthermore, the first Office Action fails to provide a reference that teaches this feature. Thus, the prior art references fail to teach or suggest all of the claim features.

Additionally, DeLorme teaches away from sorting according to proximity of a related zone of data records in relation to the position of a user. In particular, as admitted by the first

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Office Action, the user must return to the IRMIS system to modify the route or travel plan output. Accordingly, the user must leave a "zone" to sort the route or travel plan. Thus, records are not sorted according to a relation to a position of a user because the user must leave a zone to sort the records.

5 Furthermore, the first Office Action alleges various methods for database searching and sorting are well known in the art of computer programming. However, Applicants have found no teaching of such a statement in DeLorme. Furthermore, the first Office Action does not specify how such methods amount to sorting according to proximity of a related zone of data records in relation to the position of a user. If the first Office Action was implying such is well known, Applicants timely traversed this assertion and requested documentary evidence to support such an assertion in accordance with MPEP 2144.03. Applicants asserted, there is no basis for the allegation that sorting according to proximity of a related zone of data records in relation to the position of a user is well known.

10

15 Also, there is absolutely no motivation to perform sorting according to proximity of a related zone of data records in relation to a position of a user. Such motivation is not present in the cited reference and such is not well known. If the first Office Action is alleging that such is well known, Applicants traversed this assertion and requested documentary evidence to support such an assertion in accordance with MPEP 2144.03.

20 The Response to Arguments section in the final Office Action alleges "DeLorme states POI inputs are transferred and transform within the interface of a list of POIs found in proximity to a route previously computed, as revealed at 303 and detailed... in relation to Figs. 5, 6A & 6B (col. 44, lines 35-39)." The Response section further alleges, "An inputted POI is the user location." The Response section goes on to allege, "The found list POIs are the sorted record and the proximity is the zone that found the list of POIs."

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However, none of the above allegations satisfy sorting according to proximity of a related zone of data records in relation to a determined position of a user. In fact, none of the above allegations even hints at sorting anything in relation to a position of a user. The above allegations only allege an inputted POI is the user location. However, this is incorrect. In particular, a POI is a "point-of-interest" (col. 4, lines 32-31), not a user location.

Furthermore, the above noted sections do not even come close to disclosing sorting according to proximity of a related zone of data records in relation to a determined position of a user. In particular, even if any sorting were performed, all of the steps disclosed in the noted sections are performed at a home base desktop. Thus, the sorting cannot be performed in relation to a determined position of a user. More particularly, col. 44, lines 28-31 only disclose "the system also enables the generation and modification of lists of POI inputs by various methods for database searching and sorting well known in the art of computer programming." However, the system that performs database searching and sorting is only disclosed as located on a desktop computer, not on a device that can determine the position of a user within a zone. More particularly, searching and sorting is performed at a desktop computer prior to being loaded into a portable device (col. 6, lines 2-6, lines 50-53, lines 58-61, and col. 6, line 64 – col. 7, line 4). Additionally, col. 41, lines 52-60 expressly disclose the routing alleged by the Office Action is performed on a desktop, which would not bother determining the position of a user and sorting in relation to the position, because the position is always stationary. Thus, the above noted sections do not even come close to disclosing sorting according to proximity of a related zone of data records in relation to a position of a user.

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Furthermore, the final Office Action has not properly complied with MPEP §2144.03, as requested by Applicants in the first Response. Accordingly, Applicants request withdrawal of the rejections as being improper.

The Advisory Action supports Applicants assertion that a POI is not a user location. In particular, the Advisory Action states a "POI is the location of user want to be [sic]." If the POI is the location that a user wants to be, the POI cannot be a determined position of a user. In particular, the POI is a point of interest, which is a position that a user is interested in. It is not the determined position of the user.

Thus, there is absolutely no disclosure in DeLorme of sorting according to proximity of a related zone of data records in relation to a position of a user, as recited in independent claims 1, 19, 21, and 23, and such is not obvious.

Claims 9-18

Regarding claim 9, Applicants assert there is no motivation to combine Stilp et al. with Wakabayashi et al.

The first Office Action alleges such motivation is based on col. 2, lines 18-22. However, these statements only amount to the detection of fraud in a mail processing system. This does not amount to motivation to combine the teachings of Wakabayashi et al. with Stilp et al. In particular, Stilp et al. is directed to a wireless location system such as one used for E-911 calls (col. 1, lines 15-23, col. 4, lines 26-37). There is absolutely no disclosure of a mail processing system in Stilp et al. Thus, the disclosure of detecting fraud in a mail processing system in Wakabayashi et al. does not amount to motivation to combine teachings with a

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wireless location system in Stilp et al. Therefore, there is no motivation to combine the teachings of Wakabayashi et al. with Stilp et al.

The Response to Arguments section of the final Office Action disagrees with the lack of motivation to combine Stilp et al. with Wakabayashi et al. However, Applicants maintain
5 there is no motivation to combine the references.

Applicants are still confused by the final Office Action's attempt to equate location records with physical mail. Applicants cannot ascertain how physical mail is equivalent to a database record and the final Office Action provided absolutely no evidence to support this allegation. Such an allegation was not present in the first Office Action. Thus, this allegation
10 is a new grounds of rejection, as it is not present in any of the cited references. Furthermore, if the Office Action is alleging such is well known, and Applicants requested evidence to support this allegation in accordance with MPEP §2144.03.

Also, the final Office Action alleges "Stilp suggests creating a trigger wherein the trigger is sorting data system based on a location." Applicants disagree. Stilp only discloses
15 triggering the Wireless Location System to begin processing (col. 6, lines 59-61). Stilp does not disclose using a trigger to sort data based on a location.

Additionally, the final Office Action goes on to allege, "for example, the Wakabayashi is the mail sorting system based on the detecting of postal zone numbers." Yet, this does not amount to motivation to combine the references. In particular, Stilp et al. has no disclosure of
20 postal zone numbers. Stilp et al. also has no disclosure of a mail sorting system. Thus, the Office Action still has not provided proper motivation to combine the references.

Thus, there is no motivation to combine Stilp et al. with Wakabayashi et al.

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Therefore, Applicants respectfully submit that independent claims 1, 9, 19, 21, and 23 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter.

Accordingly, kindly reverse and vacate the rejections of Claims 1-24 with instructions
5 for the Examiner to allow Claims 1-24 to issue as a United States Patent.

CONCLUSION

In view of the discussion above, the Claims of the present application are in condition
10 for allowance. Kindly withdraw any rejections and objections and allow this application to issue as a United States Patent without further delay.

The Commissioner is hereby authorized to deduct the amount of \$340 for filing a brief in support of an appeal and any fees arising as a result of this Appeal Brief or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

15

Respectfully submitted,



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20

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IX. APPENDIX

Claims involved in the appeal:

- 5 1. A method for sorting data records comprising:
 - (a) determining a position of a user within a zone; and
 - (b) sorting data records, wherein said data records are associated with a related zone, wherein sorting is according to proximity of said related zone of said data records in relation to said position of the user.
- 10 2. The method according to claim 1, further comprising:
 - (c) resorting said data records upon a change in said position of the user.
3. The method according to claim 2, wherein said step (c) comprises at least one of:
 - (1) dynamically detecting said change in said position of the user;
 - (2) resorting said data records upon a change in said position of the user to within another zone;
 - (3) resorting upon detecting a change in said position of the user to a new zone;
 - (4) resorting upon receiving a resort request;
 - 15 (5) resorting upon receiving a resort request from the user; and
 - (6) polling a device associated with the user to determine said change in said position of the user.
- 20 4. The method according to claim 1, wherein said step (a) comprises at least one of:

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- (1) determining said zone of said position of the user;
- (2) receiving said position of the user; and
- (3) polling a device associated with the user to determine said position of the user.

5 5. The method according to claim 1, wherein said data records comprise at least one of:
items on a shopping list, wherein said zone comprises at least one of an aisle
and a floor in a store;

10 items slated for delivery comprising at least one of mail and packages;
radio stations, wherein said zones comprise a geographic area; and
attractions at a theme park, wherein said zones comprise at least one of events,
rides, restaurants, and buildings of said theme park.

6. The method according to claim 1, further comprising at least one of:

15 (c) sorting said data records based on a sorting index; and
(d) sorting said data records based on another sorting index.

7. The method according to claim 6, wherein said sorting index and said other sorting
index include at least one of:

20 cost;
time;
duration;
distance;
alphabetical order; and
wait time.

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8. The method according to claim 1, wherein said zone comprises at least one of:
 - an externally definable zone, definable by at least one of a user signal and a network signal;
 - 5 a user identifiable zone; and
 - a non-user identifiable zone.
9. A communication device comprising:
 - 10 a processor operative to access a plurality of records and position information, wherein the processor is operative to sort said plurality of records based on a first detected position.
 - 15 10. The communication device according to claim 9, wherein said processor is further operative to resort said records based on a second detected position.
 11. The communication device according to claim 9, further comprising:
 - a detector operative to detect a change in position of a user device.
 12. The communication device according to claim 11, wherein said detector comprises at 20 least one of:
 - a positioning device;
 - a global positioning system;
 - a receiver operative to receive position information; and
 - three or more receivers operative to detect by triangulating said position.

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13. The communication device according to claim 9, further comprising:
 - a transmitter operative to transmit said change in position of said user device.
- 5 14. The communication device according to claim 9, further comprising:
 - a storage device operative to store and retrieve said records and position information.
- 10 15. The communication device according to claim 9, further comprising:
 - a zone detector operative to receive zone information.
- 15 16. The communication device according to claim 15, wherein said zone detector is responsive to said zone information wherein said zone information is externally definable.
- 20 17. The communication device according to claim 16, wherein said externally definable zone information is responsive to at least one of:
 - a user signal; and
 - a network signal.
18. The communication device according to claim 15, further comprising a user interface wherein said zone detector is operative to detect zone responsive to at least one of:
 - a user input signal;
 - a network signal;

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a position detector;
a user identifiable zone; and
a non-user identifiable zone.

5 19. A system for sorting data records comprising:
means for determining a position of a user within a zone; and
means for sorting data records according to proximity to said position of the user.

10 20. The system according to claim 19, further comprising:
means for resorting said data records upon a change in said position of the user.

15 21. A system operative to sort data records comprising:
a position detector operative to determine a position of a user within a zone;
a proximity sorter operative to sort data records according to proximity to said position
of the user.

20 22. The system according to claim 21, further comprising:
a proximity resorter operative to resort said data records upon a change in said position
of the user.

23. A computer program product embodied on a computer readable medium, the computer
program product including program logic comprising:
program code means for enabling a computer to determine a position of a user within a
zone; and

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program code means for enabling the computer to sort data records according to proximity to said position of the user.

24. The computer program product of claim 23, further comprising:

5 program code means for enabling the computer to resort said data records upon a change in said position of the user.

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